



Attorney Docket No. VX9614638 PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Inventor(s) : Takayuki Araki *et al.*
Serial Number : 09/095,842
Filed : June 11, 1998
For : AQUEOUS DISPERSION OF VINYLIDENE FLUORIDE
POLYMER AND PREPARATION PROCESS THEREOF
Examiner : Peter Szekely
Group Art Unit : 3611

**PETITION UNDER 37 C.F.R. §1.181 TO RESCIND AND WITHDRAW THE
DECISION OF THE TECHNOLOGY CENTER DIRECTOR REOPENING
PROSECUTION OF THIS APPLICATION UNDER 37 C.F.R. §1.198 AFTER A
DECISION BY THE BOARD OF PATENT APPEALS AND INTERFERENCES.**

**Attention: Office of a Deputy Commissioner
for Patent Examination Policy**

The Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 22, 2004

Dear Sir:

Applicant respectfully requests the granting of this petition for the relief requested in the following pages. Facts and arguments concerning the requested relief follow.

REQUESTED RELIEF

Applicant petitions to rescind and withdraw the decision of the Technology Center (TC) Director reopening prosecution of this application under 37 CFR §1.198 and permitting the examiner to set forth a new non-prior art rejection after a decision by the Board of Patent Appeals and Interferences. Applicant further petitions the Commissioner to order the TC director and examiner to allow claims 12-17, the rejection for which was reversed on appeal. The impropriety of the TC director's decision and the need for its removal and the allowance of claims 12-17 are explained in detail below.

FEES

A check in the amount of \$130.00 (ONE HUNDRED TWENTY DOLLARS) is attached hereto for this petition as required under 37 C.F.R. §1.17(h). In the event any additional fees are due, the Commissioner is hereby authorized to charge any deficiency in the payment of necessary fee(s) or credit any overpayment thereof to our deposit account No. 22-0256.

TIMELINESS & RIPENESS

Applicants respectfully submits this petition is both ripe and timely. The TC Director's decision granting reopening of the prosecution of the application is contained within the Official action mailed July 22, 2004, by her signature

on the last page of the Official action. This petition is being filed on September 22, 2004, which is within two months from the time of the Official action mailed July 22, 2004.

FACTS

(1) The appeal to the Board was taken from the final Office action mailed May 8, 2002. In this final Office action, claims 12-17 were rejected in four separate rejections, as follows:

(a) Claims 6-11 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection repeated a rejection in the previous Office action mailed October 4, 2001.

(b) Claims 6-11 were rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure which is not enabling. The final Office action stated that the nonionic, non fluorine-containing surfactant is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. This rejection repeated a rejection in the previous Office action mailed October 4, 2001.

(c) Claims 12-14 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification of "an average particle size of not more than 320.1 nm."¹ This rejection was newly set forth in the final Office action.

¹ It is respectfully noted that the examiner's statement of the rejection does not conform with form paragraph 7.31.01 of the Manual of Patent Examination Procedure (M.P.E.P.) (Rev. 2, May 2004) §706.03(c), because it does not set forth that at the claims failed to comply with the written description requirement.

(d) Claims 15-17 were rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the specification of "an average particle size of not more than 196.3 nm."² This rejection was newly set forth in the final Office action.

(2) The examiner's answer repeated the above rejections and did not clarify whether rejections 1(c) and 1(d) were made under the enablement or written description requirement. In the rejection of claims 15-17, the examiner added that the 2.0 % by weight of fluorine containing surfactant is outside the limits of the claimed invention.

(3) The decision of the Board of Patent Appeals and Interferences (Board) mailed April 19, 2004, characterized the examiner's rejections under the first paragraph of 35 U.S.C. §112, as follows:

(a) Claims 6-11 stand rejected for lack of enablement.

(b) Claims 6-17 stand rejected for lack of written descriptive support.

The decision of the Board reversed rejection (3)(b). The Board affirmed rejection (3)(a). Only two of three Board members concurred in affirming rejection (3)(a). The most experienced and respected administrative patent judge, the Honorable Bradley R. Garriss, of the three Board members set forth a strong dissent of the majority's decision affirming the rejection of claims 6-11

² Ibid.

as failing to satisfy the enablement requirement of 35 U.S.C. §112, first paragraph.

(4) The Office action mailed July 22, 2004, after the reopening of the prosecution by the TC director, set forth a new rejection of applicant's claims 12-17 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The examiner's supporting statements for this new rejection can be characterized into two groups of facts or arguments as follows:

(a) Claims 12-14 totally encompass the material claimed in canceled claims 6-11, which were held unpatentable by the Board and claims 15-17 overlap 98% of the material claimed in canceled claim 6-11, which were held unpatentable by the Board. For these reasons, the examiner held that claims 12-17 are based on a disclosure that is not enabling.

(b) There is no mention in the specification of "an average particle size of not more than 320.1 nm," "an average particle size of more than 196.3 nm" or the "surfactant content of the more than 2%" in this specification.

ARGUMENTS

(A) APPLICANT RESPECTFULLY REQUESTS THAT THE TC DIRECTOR'S DECISION REOPENING PROSECUTION BE RESCINDED AND WITHDRAWN FOR FAILING TO ESTABLISH "SUFFICIENT CAUSE" FOR REOPENING OF PROSECUTION OF AN APPLICATION AFTER A DECISION BY THE BOARD.

The reopening of prosecution of an application after a decision by the Board is governed by 37 C.F.R. § 1.198, which reads as follows:

Cases which have been decided by the Board of Patent Appeals and Interferences will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.114 or § 1.196 without the written authority of the Director, and then only for the consideration of matters not already adjudicated, *sufficient cause being shown*. (Emphasis added).

In summary, after a decision by the Board, the examiner must get the approval of the TC Director to reopen prosecution and set forth a new rejection. The TC Director's approval (Ms. Jacqueline M. Stone) appears on the last page of the outstanding Office action. It is the policy of the Patent Office not to reopen prosecution of an application after a decision by the Board unless sufficient cause is shown.

There is no showing or statement in the Office action mailed July 22, 2004, concerning sufficient cause for reopening prosecution. Since there is no showing or statement of sufficient cause for reopening prosecution of the present application, the TC director's decision reopening of prosecution of the application does not and cannot satisfy the requirements set forth and 37 C.F.R. §1.198. Therefore, this decision reopening prosecution must be rescinded and withdrawn.

(B) THE CONTENT OF OFFICE ACTION MAILED JULY 22, 2004, SETS FORTH MATTERS ALREADY ADJUDICATED BY THE BOARD, AND THEREFORE, THE PROSECUTION OF THESE ISSUE(S) CANNOT BE REOPENED.

The examiner's facts or arguments supporting the new rejection in the Office action mailed July 22, 2004, were summarized above in Facts (4)(a) and (4)(b). The Board adjudicated some of issues raised by these facts or arguments in the new rejection. None of these facts or arguments set forth by the examiner in the new rejection establishes sufficient cause for reopening prosecution of the present application.

Considering facts or arguments (4)(b), it is respectfully noted that the Board answered these facts or arguments of the examiner in the paragraph bridging pages 9 and 10 of the decision. These identical facts or arguments were set forth in the examiner's answer before the Board. The examiner's recharacterizing of these facts or arguments under the heading of "nonenablement" does not change their relationship to the first paragraph of 35 U.S.C. §112. This is still a written description issue that was already decided by the Board on appeal. The Board stated that the examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by the claims, *in re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976). The examiner never did so and still has not done so. Since the Board already considered facts or arguments (4)(b) of the examiner in its decision and reversed the examiner, this issue was adjudicated by the Board. Therefore, applicant respectfully requests that the Commissioner direct the TC director

and examiner to withdraw the rejection of applicant's claims 12-17 newly set forth after the decision by the Board and allow claims 12-17, because the issues presented by the examiner were already adjudicated by the Board.

- (C) THE CONTENT OF THE OFFICE ACTION MAILED JULY 22, 2004, SETS FORTH ISSUE(S) ALREADY ADJUDICATED DURING THE PROSECUTION OF THIS APPLICATION, AND THEREFORE, THE PROSECUTION OF THESE ISSUE(S) CANNOT BE REOPENED.

The foregoing Facts (1)-(4) can be summarized as follows. The examiner made general rejections under 35 U.S.C. §112, first paragraph, noting neither the enablement requirement nor the written description requirement. It was the applicant's understanding that the rejections included both of the enablement and written description requirements. Applicant's appeal brief explained that the rejection was only appropriate under the written description requirement of the first paragraph of 35 U.S.C. §112. Since the examiner did not challenge, or make any comment about applicant's explanation of the rejections as only under the written description requirement in the examiner's answer, the examiner effectively withdrew any allegedly nonenablement requirement rejection. At the time of the examiner's answer, the examiner already made his decision or consideration concerning whether or not applicant's claims 12-17 comply with the enablement requirement of the first paragraph of 35 U.S.C. §112. Alternatively, the examiner could have and should have made (or clarified) this rejection at the time of the examiner's

answer, final rejection, or earlier, if it was believed appropriate. Since the examiner already decided not to make a rejection of applicant's claims 12-17 under the enablement requirement or since the examiner had ample opportunity to make this rejection and did not, the examiner is estopped from making this rejection at this time. For these reasons, the issue of whether or not claims 12-17 comply with the enablement requirement of the first paragraph of 35 U.S.C. §112 was already decided by the examiner and thus adjudicated. Therefore, applicant respectfully requests that the Commissioner direct the TC Director and examiner to rescind and withdraw the Office action mailed July 22, 2004, and allow claims 12-17, because the issues in the new rejection mailed July 24, 2004, were already adjudicated.

- (D) THE CONTENT OF THE OFFICE ACTION MAILED JULY 22, 2004, DOES NOT SET FORTH ANY ADDITIONAL FACTS OR ARGUMENTS THAT CAN ESTABLISH "SUFFICIENT CAUSE" FOR REOPENING OF PROSECUTION OF AN APPLICATION AFTER A DECISION BY THE BOARD.

The examiner's reasoning set forth in Facts 4(a) above is irrelevant to the issue of enablement. In particular, whether certain claims set forth subject matter that is encompassed by other claims has nothing to do with the first paragraph of 35 U.S.C. §112. Claims must be enabled by the specification, not by other claims. In other words, the first paragraph of 35 U.S.C. §112 requires that the claims are enabled by the specification. There is no mention of other claims in the statute and the consideration of other claims can provide no

probative value for determining enablement under the first paragraph of 35 U.S.C. §112.

Consider a simple fact situation. A patent application specification described a composition comprising 10 wt% of compound A in solvent X. Original claim 1 of the application defined a composition comprising 10 weight % of compound A in solvent X. Claim 2 was added to the application after the filing of the application and defined composition comprising 10 weight % of compound A and 5 weight % of compound B in solvent X. It can be argued that claim 2 failed to comply with the enablement requirement and the written description requirement of 35 U.S.C. §112, first paragraph. Claim 1 totally encompasses claim 2. Claim 1 complies with the enablement requirement and the written description requirement of 35 U.S.C. § 112, first paragraph. In this simple example, the fact that claim 1 totally encompasses claim 2, which allegedly fails to comply with the enablement requirement and the written description requirement of 35 U.S.C. §112, first paragraph, has absolutely no bearing on whether or not claim 1 complies with the enablement requirement and the written description requirement of 35 U.S.C. §112, first paragraph. This simple example shows that a broader claim (claim 1) can satisfy the enablement requirement and the written description requirement of 35 U.S.C. §112, first paragraph, while a more narrow claim (claim 2) may not satisfy the

enablement requirement and the written description requirement of 35 U.S.C. §112, first paragraph.

The aforementioned simple example demonstrates that the facts or arguments, as identified in Facts 4(a) above, set forth by the examiner in the new rejection after the reopening of prosecution of this application are meaningless and have absolutely no bearing on whether or not claims 12-17 comply with the enablement requirement of 35 U.S.C. §112, first paragraph. Therefore, these facts or arguments of the examiner cannot establish sufficient cause for reopening prosecution of this application as required under 37 C.F.R. §1.198. Therefore, applicant respectfully requests that the Commissioner direct the TC Director and examiner to rescind and withdraw the Office action mailed July 22, 2004, and allow claims 12-17.

(E) THE CONTENT OF THE OFFICE ACTION MAILED JULY 22, 2004, DOES NOT SET FORTH A PROPER REJECTION UNDER 35 U.S.C. §112, FIRST PARAGRAPH, AND THEREFORE CANNOT ESTABLISH "SUFFICIENT CAUSE" FOR REOPENING OF PROSECUTION OF AN APPLICATION AFTER A DECISION BY THE BOARD.

As explained in the M.P.E.P. §2164.01, any analysis of whether a particular claim is supported by the disclosure in an application requires determination of whether that disclosure, when filed, contain sufficient information regarding the subject matter of the claims as to enable one skilled

in the pertinent art to make and use the claimed invention. As set forth in the M.P.E.P. §2164.01(a):

There are many factors to be considered in determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue." These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The outstanding Office action includes none of these considerations, and therefore, does not and cannot set forth sufficient cause for making the new ground of rejection set forth therein. For these reasons, applicant respectfully requests that the Commissioner direct the TC Director and examiner to rescind and withdraw the rejection of applicant's claims 12-17 set forth after the decision by the Board and allow claims 12-17.

- (F) APPLICANT'S CLAIMS 12-17 ARE ENABLED BY THE PRESENT SPECIFICATION DISCLOSURE WITHIN THE MEANING OF 35 U.S.C. §112, FIRST PARAGRAPH, AND THEREFORE A REJECTION ON THIS BASIS CANNOT ESTABLISH "SUFFICIENT CAUSE" FOR REOPENING OF PROSECUTION OF AN APPLICATION AFTER A DECISION BY THE BOARD.

The presence of comparative examples 4 and 5 in applicant's specification enables the invention set forth in claims 12-17. As explained in M.P.E.P. §2164.01(b), "As long as the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claimed, then the enablement requirement of 35 U.S.C. 112 is satisfied, *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970)." Since comparative examples numeral 4 and 5 contain the upper limits for average particle size and amount of fluorine-containing surfactant of applicant's claims 12-17, they at least enable the invention set forth in claims 12-17. As explained in M.P.E.P. §2164.01(b), "A single working examples in the specification for a claimed invention is enough to preclude a rejection which states that nothing is enabled since at least that embodiment will be enabled." Since comparative examples numeral 4 and 5 contain the upper limits for average particle size and amount of fluorine-containing surfactant of applicant's claims 12-17, they at least enable the invention set forth in claims 12-17.

Furthermore, after a review of applicant's specification, one of ordinary skill in the art would easily have been enabled to make and use the invention as set forth in claims 12-17. As explained in applicant's specification and appeal brief, it was difficult in the prior art to obtain an aqueous dispersion having both a small particle size and high solids content. This is because the

size of the particles in the aqueous dispersion usually tended to increase together with an increase in polymer concentration (high solids content). On the other hand, in the prior art, when the amount of surfactant was increased, the particle size was reduced; but unfortunately, the polymer (solids) content was also reduced. This latter fact is evidenced by comparative examples 3 and 5 in Table 1 on page 13 of applicant's specification disclosure. These comparative examples contain the same monomers and surfactant. A difference between these two comparative examples is that comparative example 5 contains significantly more fluorine-containing surfactant than comparative example 3, which resulted in a desirable reduction in particle size and an undesirable reduction in solids content.

Comparative examples 4 and 5 set forth the upper limits for average particle size and fluorine-containing surfactant set forth in claims 12-14 and 15-17, respectively. Comparative examples 4 and 5 also set forth a solids content within the range of applicant's claims. These comparative examples set forth a recipe that would enable one of ordinary skill in the art to make the compositions described therein, which contain the upper limits for average particle size and amount of fluorine-containing surfactant of applicant's claims. If one of ordinary skill in the art desired a different particle size or solids content, he could simply use a different amount of fluorine-containing surfactant, a different fluorine-containing surfactant, change the monomer

components, or the amounts of monomer components, among other things known to those persons skilled in this art. This is shown in comparative examples 1-5.

From the above, it is readily apparent that claims 12-17, now pending in the application, are enabled by the present specification disclosure within the meaning of 35 U.S.C. §112, first paragraph. Therefore, the rejection under these ground set forth in the new rejection cannot establish sufficient cause for reopening the prosecution of this application.

For these reasons, applicant respectfully requests that the Commissioner direct the TC Director and examiner to rescind and withdraw the rejection of applicant's claims 12-17 set forth after the decision by the Board and allow claims 12-17.

(G) ANY DETERMINATION OF "SUFFICIENT CAUSE" FOR REOPENING OF PROSECUTION OF AN APPLICATION AFTER A DECISION BY THE BOARD MUST CONSIDER THE ADVERSE EFFECTS AND DAMAGE COSTS SUFFERED BY THE APPLICANT WHEN REOPENING PROSECUTION, AND IN THE PRESENT FACTUAL SITUATION, SUCH FACTORS NEGATE "SUFFICIENT CAUSE" FOR REOPENING THE PROSECUTION OF THE APPLICATION.

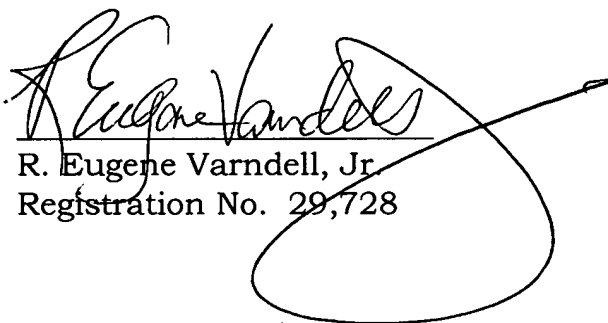
The allowance of claims 12-17 in the present application has been seriously delayed by the examiner's inappropriate actions. These delays included an appeal to the Board that was based on a notice of appeal filed August 8, 2002, and that continues until today, over two years. The decision

of the Board reversed many of the examiner's rejections. The only rejection of the examiner, which was affirmed by the Board, was affirmed only by two of the three Board members. The most experienced and respected administrative patent judge, the Honorable Bradley R. Garriss, of the three Board members set forth a strong dissent of the majority's decision affirming the rejection of claims 6-11 as failing to satisfy the enablement requirement of 35 U.S.C. §112, first paragraph. The applicant could have appealed the majority decision to a court of law, where it is believed that the chances of reversing the majority Board decision were excellent. In order to obtain patent rights more quickly, the applicant decided to delete claims that were rejected by the examiner and affirmed by the Board, so that claims rejected by the examiner but reversed by the Board would be allowed. Permitting a rejection of applicant's claims at this time on an issue that was previously decided or should have been previously decided denies applicant due process of law and is arbitrary and capricious. Furthermore, no sufficient cause was set forth in the new rejection supporting the reopening of the prosecution of this application. Therefore, applicant respectfully requests that the Commissioner direct the TC Director and examiner to rescind and withdraw the rejection of applicant's claims 12-17 set forth after decision by the Board and allow claims 12-17.

CONCLUSION

For the foregoing reasons, applicant respectfully petitions the Commissioner to rescind and withdraw the TC Director's decision reopening prosecution for lack of sufficient cause being shown to make the new rejection or because the issue(s) in the new rejection was (were) already adjudicated. Along these lines, applicant respectfully petitions that the Commissioner to rescind and withdraw the Office action mailed July 22, 2004. Applicant also respectfully petitions that the Commissioner direct the TC Director and examiner to allow pending claims 12-17.

Respectfully submitted,
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